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OFFICE OF PETITIONS

In re Application of :
Khalid Raja, Frank D'Amelio, Dennis Caudle, :
Roger Raetzman, Kevin Wood, and Marvin :
Parrett :
Application No. 10/692,363 :
Filed: October 22, 2003 :
Attorney Docket No.: ACMI-2.006.US :
Title: FLUID DELIVERY SYSTEM FOR USE :
WITH A SURGICAL PUMPING UNIT :

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed June 8, 2004.

The above-identified application was filed on October 22, 2003, identifying Khalid Raja, Frank D'Amelio, Dennis Caudle, Roger Raetzman, Kevin Wood, and Marvin Parrett as joint inventors. The application was filed with neither an oath nor a declaration. On January 22, 2004, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (first notice), requiring an executed oath or declaration in compliance with 37 C.F.R. §1.63 and a surcharge for its late filing. This Notice set a two-month period for reply.

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

On May 21, 2004, an improperly executed declaration was submitted, and on June 4, 2004, a "Notice of Incomplete Reply – Nonprovisional" (second notice) was mailed, indicating that the submission was not acceptable. The second notice did not extend the period for response set by the previous mailing.

In reply to the second notice, applicant filed the instant petition, the petition fee, and the surcharge associated with the late filing of an oath or declaration. To make timely this reply, a two-month extension of time was requested.

Petitioner has also submitted a declaration executed by each of the joint inventors save Mr. Wood, a statement of facts, the last known address of the non-signing inventor, and copies of several letters.

Petitioner has met requirements (1) – (3) above.

Regarding the fourth requirement above, both the statement of facts and the copies of the letters which were sent to the non-signing inventor make it clear that only the declaration was sent to him. As such, Petitioner has shown that a complete copy of the application was not sent to the non-signing inventor. Petitioner's showing is insufficient to evince, as required, that Rule 47 applicant presented the inventor with a copy of the entire application.

Furthermore, it follows that one cannot refuse to sign something which one has not been presented with. A refusal by an inventor to reply to the e-mails and telephone messages described in the declaration of facts does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed².

Regarding the fifth requirement above, the declaration is not compliant with 28 U.S.C. 1746, in that signing joint inventor D'Amelio has failed to affix a date underneath his signature.

On renewed petition, Petitioner may either: mail a complete copy of the application to the non-signing inventor and submit proof of the same, coupled a declaration which has been properly executed by joint inventor D'Amelio, or; a declaration which has been properly executed by each of the inventors.

For these reasons, the petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The renewed petition should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)," and should display "Please deliver to Paul Shanowski, c/o Office of Petitions" in a prominent manner.


² In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail³, hand-delivery⁴, or facsimile⁵.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

³ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁴ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁵ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.